

REMARKS

This application contains claims 1-16, the status of which is as follows:

- (a) Claims 2-10 and 12-15 are as originally filed.
- (b) Claims 1 and 11 have been currently amended.
- (c) Claim 16 is previously presented.

No new matter has been added. Reconsideration is respectfully requested.

The Applicant thanks Examiner Hoekstra for the courtesy of a personal interview with the Applicant's representative, Daniel M. Goldstein (Reg. No. 44,127), held in the USPTO on April 8, 2008. At the personal interview, the Applicant's representative and the Examiner discussed a proposed amendment to claims 1 and 11 to overcome the rejection of these claims under 35 U.S.C. 103(a) over US Patent 3,895,637 to Choy in view of US Patent Application Publication 2003/0153866 to Long et al. The proposed amendment would recite "said guidewire slidably disposed within said bore." Additionally, the Examiner and Applicant's representative discussed the language in claim 16 that reads "...sliding a gastrointestinal tool over and relative to said guidewire such that said guidewire passes through a bore of said gastrointestinal tool,..." The Examiner suggested that the Applicant clearly state on the record that this language only includes a case in which the guidewire passes through the bore of the tool. The Examiner's suggestion was intended to address the Examiner's concern that Fig. 21 of Long et al. could be interpreted as showing a tool (medical instrument 524) passing literally over (rather than around) a guidewire (the tube in umbilicus 540 that is lower on the page than medical instrument 524). The Examiner indicated that a cursory review of the proposed amendment and the Applicant's statement to be put on the record would appear to obviate the rejection of the claims, and that the claims would be reviewed for patentability upon formal entry.

In light of the above, the Applicant hereby confirms that the intended scope of all of the claims, including claim 16, relates to a guidewire that is within the bore of the gastrointestinal tool during use, and that the meaning of sliding the tool *over* the guidewire does not include within its scope a situation where the tool is simply above the guidewire (i.e., where the tool is at a higher height than the guidewire). The

Applicant notes that it is the Applicant's belief that Fig. 21 of Long et al. does not show a tool passing over a guidewire, using the normal understanding of the meaning of "passing a tool over a guidewire" as used by a person of ordinary skill in the art of GI tract tools.

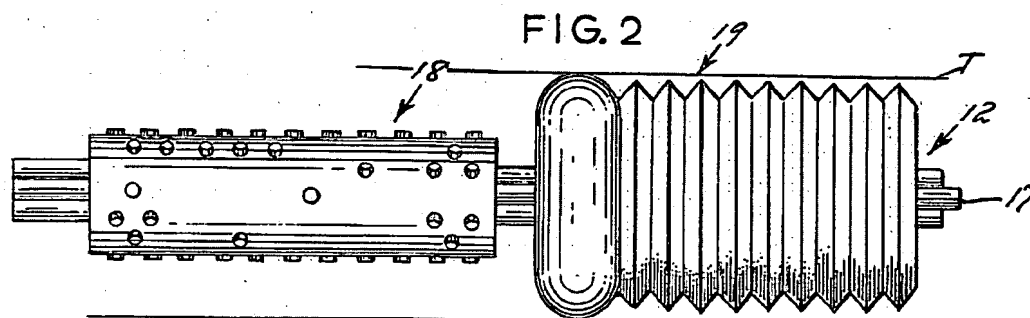
Claim rejections under 35 U.S.C. 103

Claims 1-7 and 11-16 were rejected under 35 U.S.C. 103(a) over US Patent 3,895,637 to Choy in view of US Patent Application Publication 2003/0153866 to Long et al.

The Examiner contended that Choy teaches all of the elements of claims 1, 11 and 16 except that the gastrointestinal tool slides relative to the guidewire after the guidewire is pulled by the inflatable device, and that Long et al. teaches a guidewire that is pulled by a pulling device, and thereafter a gastrointestinal tool slides over and relative to the guidewire.

As shown in Fig. 2, Choy describes a self-propelled device that comprises an inflatable device, which comprises two inflatable elements: an inflatable anchor member 18 and an inflatable advancing member 19. Together, these two inflatable elements advance a multilumen tubular member 12 through a body lumen. Tubular member 12 includes a service tube 17, which is brought to the desired area of the tubular organ to facilitate a treatment.

Fig. 2 of Choy shows:



As shown in Fig. 21, Long et al. describes a self-propelled GI capsule 500 having an umbilicus 540 through which a medical instrument 524 can be introduced:

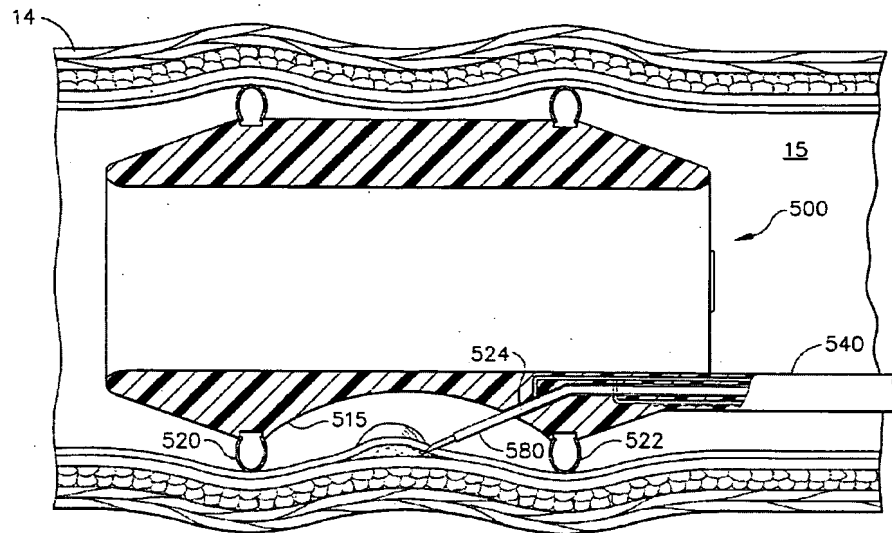


FIG. 21

The Examiner has asserted the following correspondence between the elements of claim 1 and the elements of Choy and Long et al.:

Claim 1	Choy	Long et al.
a guidewire	service tube 17	umbilicus 540
a gastrointestinal tool formed with a bore	inflatable anchor member 18	[no corresponding element]
said guidewire passing through said bore such that said gastrointestinal tool slides over said guidewire	[no corresponding element]	medical instrument 524 "slides over and relative to such guidewire" [see discussion above regarding the meaning of a tool passing "over" a guidewire, which clarifies that the scope of Long's medical instrument 524 does not pass over a guidewire]
wherein said gastrointestinal tool has at least one functionality selected from the group consisting of: diagnostic functionality and therapeutic functionality	inflatable anchor member 18 has a lumen for introduction of medical instruments and fluids (col. 1, lines 10-16 and 48-54) or an image viewing device (col. 1, lines 10-16)	medical instrument 524
an inflatable device, adapted to pull said guidewire through a colon	inflatable advancing member 19	capsule 500

wherein said guidewire is pulled by said inflatable device and following pulling of said guidewire by said inflatable device, said gastrointestinal tool slides relative to said guidewire	[no corresponding element identified]	medical instrument 524 "slides over and relative to such guidewire" [see note above re "over"]
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Applicant respectfully submits that even if Choy and Long et al. could be properly combined, together they would not teach all of the elements of claims 1, 11 and 16. In particular, Choy does not describe a gastrointestinal tool that passes over a guidewire, as recited in claims 1, 11 and 16. Inflatable anchor member 18 of Choy is not a gastrointestinal tool. Member 18 serves no diagnostic or therapeutic function; the sole function attributed by Choy to member 18 is advancement of the apparatus through the body lumen;

Choy does not describe a gastrointestinal tool that passes over a guidewire. The sole function attributed by Choy to member 18 is advancement, which means that member 18 is properly viewed as corresponding to an element of the "inflatable device" of claim 1, rather than to the gastrointestinal tool of claim 1.

The only gastrointestinal tool possibly described by Choy is service tube 17, which the Examiner has equated with the guidewire of claim 1. Service tube 17 cannot correspond to both the gastrointestinal tool and the guidewire recited in claim 1 (clearly, service tube 17 cannot slide over itself). (Even if it were granted for the sake of argument that inflatable anchor member 18 is a tool, anchor member 18 does not slide over service tube 17 (corresponding to the guidewire). Instead, anchor member 18 is fixed to service tube 17.)

Sliding the gastrointestinal tool over the guidewire is an essential feature of claim 1 which is entirely absent in Choy. The entire reason the guidewire is advanced through the gastrointestinal tract is to subsequently slide the gastrointestinal tool over the guidewire. (This is the whole point of a guidewire.) Choy does not describe service tube 17 as serving the function of a guidewire.

Long et al. do not describe a guidewire. Long et al. call element 540 an "umbilicus," and not a guidewire, and this element is neither described nor shown as functioning as a guidewire

Long et al. describe an "umbilicus 540" having at its end a "port 517." This umbilicus/port serves as an ordinary working channel: "For example, a very small diameter fiber optic visualization device (not shown) may be introduced through umbilicus 540 and port 517 to position recess 517 over tissue structure 13, then removed so that port 517 may be used for administering fluids, agents, and the like" (paragraph [0046]). Long et al. neither teach nor suggest that this working channel can also function as a guidewire, as the term is conventionally understood in the art.

Long et al. do not describe a "gastrointestinal tool formed with a bore," or sliding a gastrointestinal tool over and relative to a guidewire. The "medical instrument 524" of Long et al. passes through umbilicus 540, rather than over the umbilicus.

Long et al. state: "FIG. 21 illustrates a medical instrument 524 inserted through port 517 for treatment of tissue structure 31" (paragraph [0047], emphasis added).

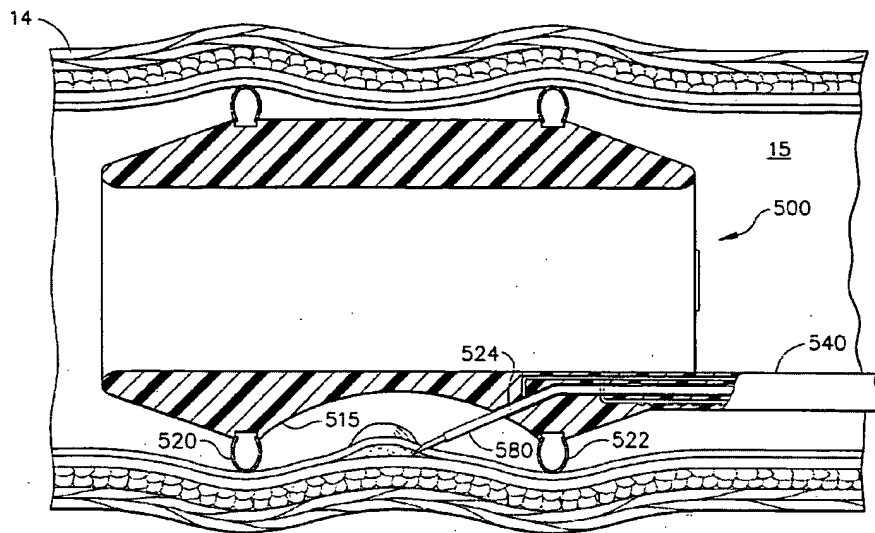


FIG. 21

The medical instrument of Long et al. does not have a bore.

Thus, neither Choy nor Long et al. teach the two critical elements of claims 1, 14 and 16 (quoted from claim 1):

- "said guidewire passing through said bore such that said gastrointestinal tool slides over said guidewire"; and
- "wherein said guidewire is pulled by said inflatable device and following pulling of said guidewire by said inflatable device, said gastrointestinal tool slides relative to said guidewire."

The Applicant believes the amendments and remarks presented hereinabove to be fully responsive to all of the grounds of rejection and objection raised by the Examiner. In view of these amendments and remarks, the Applicant respectfully submits that all of the claims in the present application are now in order for allowance. Notice to this effect is respectfully requested.

Respectfully submitted,

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Reg. No. 41,533